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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,378	01/16/2001	Teiji Mizutani	892_014	5329

25191 7590 03/22/2005

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EXAMINER	
DURAN, ARTHUR D	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

3/7/05

Office Action Summary	Application No. 09/761,378	Applicant(s) MIZUTANI, TEIJI	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JEFFREY D. CARLSON
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-11 have been examined.

Response to Amendment

2. The Amendment filed on 1/25/05 is insufficient to overcome the LaLonde, Rogers, and Eggleston reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaLonde (WO 94/15294) in view of Rogers (US 5,978,774) and in view of Eggleston (6,061,660).

LaLonde discloses:

a notice control module for controlling a notice of information (page 20);

a control module for registering, as applicant information, attributes of applicants who apply for the information (page 20-21);

a content data creating module for creating content data in accordance with the attribute of the applicants in the applicant information (page 22 lines 24-35); and

a transmitting module for transmitting the content data to the corresponding applicant (page 24 lines 29-31 wherein the disclosed agent mail, fax, or phone notification is considered

patentably synonymous to the claimed transmitting module). LaLonde is considered to also disclose the claimed application accept module (page 23 lines 10-11), storage module (page 22 line 15), applicant commercial article relation attribute (page 22 line 37 wherein the disclosed similar properties established the claimed applicant commercial article relation attribute because both are types of consumer profiling), content data creating module based on information acquired (page 22 lines 25-26 because the disclosed agent consumer notification bases the notification on information acquired), and accessing other set of content data (page 23 line 1 wherein the disclosed comparable items is considered patentably equivalent to other content data).

Rogers further discloses:

controlling a notice of information (column 4 lines 53-63);

registering, as applicant information, attributes of applicants who applied for the prize information (column 4 lines 53-63 wherein the disclosed electronic registration performs the claimed registering);

creating content data in accordance with the attributes of the applicants in the applicant information (column 6 lines 2-5 wherein the disclosed database inclusion indications are considered patentably equivalent to the claimed content data creation because both are considered to create content in accordance with the attributes of the applicants in the applicant information, in this case the disclosed store associate serves as the claimed applicant);

transmitting the content to the corresponding applicant (column 6 lines 6-13 wherein the disclosed printed receipt is considered to anticipate the claimed transmission). Rogers is considered to also disclose the claimed receiving the applicant information on the attributes of

the applicants (column 6 lines 12-13), wherein the applicant information contains an attribute for representing a relation between a commercial article in a predetermined category and the applicant (column 6 lines 14-22), acquiring article information on the commercial article in the predetermined category (column 6 lines 23-33), creating the content data on the basis of the article information of the article information acquired (column 6 lines 42-52), and creating other set of content data corresponding to the applicant information, wherein the content data contain a piece of information for accessing other set of content data (column 6 lines 53-65).

Rogers further discloses a gift (col 1, lines 35-40; col 2, lines 20-25).

Eggleston discloses prizes and awards programs and that they can utilize the Internet (col 1, lines 20-30); that the users can register or apply for prize information (col 12, lines 20-37); that the user is profiled (col 13, lines 5-30); and that targeted content is sent to the user based on user characteristics (col 42, lines 35-40). Eggleston further discloses catalogs of products and prizes (col 15, lines 3-10).

Eggelston further discloses both prize information and content information such as advertising, product testing, and surveys (col 1, lines 35-42; col 13, line 65-col 14, line 5; col 30, line 24-30; col 34, lines 40-54).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Rogers item and user registering features and Eggleston's prizes as incentive, profiling, targeting, customized content, and inciting a user to certain actions to Lalonde's customized content based upon user characteristics. One would have been motivated to do this in order to provide a further way to attain information about a user and better ways to incite and advertise to a user.

Additionally, Eggleston discloses prizes as incentives to promote particular user behaviors which can include making a new purchase (col 1, lines 20-46). Eggleston's users do not have to make a purchase to receive the prize or award. Rather, as noted in the citation, prizes or awards can be utilized as a promotion to incite the user to make a purchase. Also, Eggelston shows that the user does not have to first make a purchase in order to receive prizes or awards (Fig. 8; col 9, lines 5-10).

Response to Arguments

4. Applicant's arguments with respect to claims 1-11 have been considered but are not found persuasive.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Additionally, Eggleston discloses prizes as incentives to promote particular user behaviors which can include making a new purchase (col 1, lines 20-46). Eggleston's users do not have to make a purchase to receive the prize or award. Rather, as noted in the citation, prizes or awards can be utilized as a promotion to incite the user to make a purchase. Also, Eggelston

shows that the user does not have to first make a purchase in order to receive prizes or awards (Fig. 8; col 9, lines 5-10).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/7/05

JEFFREY D. CARLS
PRIMARY EXAMINER